

Application No: 09/902,407  
Attorney's Docket No: US010319

### **REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. Claims 1, 14, and 15 are amended. Currently, claims 1-15 are pending in the present application of which claims 1, 14, and 15 are independent.

Claims 1, 14 and 15 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The last sentence of this rejection appears to be a separate rejection on the grounds of alleged indefiniteness. These rejections are respectfully traversed for at least the reasons set forth below.

Claims 2 and 9 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kramer et al. in view of Sciammarella et al. (U.S. Patent Number 5,982,369). Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kramer et al. in view of Sciammarella et al. and further in view of Official Notice. Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kramer et al. in view of Shaw (Newspapers and the Future: First of two parts.) The above rejections are respectfully traversed for at least the reasons set forth below.

#### **Claim Rejection Under 35 U.S.C. §112**

The basis for the rejection under 35 U.S.C. § 112, first paragraph, arises from subject matter added to the claims by the Amendment filed January 5, 2006. All of this subject matter is hereby deleted from the claims. Therefore, it is respectfully submitted that the basis giving rise to the rejections under 35 U.S.C. § 112 no longer exists. For at least the foregoing reasons, it is



Application No: 09/902,407  
Attorney's Docket No: US010319

respectfully requested that the rejections of claims 1, 14 and 15 under 35 U.S.C. § 112 be withdrawn.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1, 5, 8, and 10-15 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kramer et al. This rejection is respectfully traversed because the claimed invention as set forth in amended claims 1, 14, and 15 and the claims that depend therefrom are patentably distinguishable over Kramer et al.

Kramer et al. discloses a system and method providing for the interpretation and augmenting of structured documents electronically delivered to an individual consumer's



Application No: 09/902,407  
Attorney's Docket No: US010319

computer using consumer profiles developed from and maintained with information reflecting the consumer's online and offline transactions, by selecting the variable content alternatives encoded in the structured documents that most closely match the consumer's profile. The consumer profiles are logically controlled by the consumer's computer, thus providing for enhanced security over information that is personal and confidential to the consumer, yet still allowing third parties such as web sites and others electronically delivering structured documents to the consumer to have such documents customized based on the consumer's profile. The consumer profile includes hierarchical attribute vectors which encode attributes of a consumer at progressively higher levels of abstraction, and allowing for querying of any combination of abstracted data or abstracted attributes of a consumer. The consumer profiles are updated with a process that reflects the relevance of each transaction to the consumer's profile, and accommodates a decay in the influence of transactions over time. A selection process for selecting content allows for multiple items of content to be selected for sequenced display to the consumer, through a limited presentation space.

According to one embodiment in the present application, a recommender system receives an input representative of an offer or other opportunity, and one or more user-specified limiting factors. The recommender system generates the recommendation based at least in part on the input and a stored profile associated with the processing device. A characteristic of the manner in which the recommendation is generated is determined in accordance with the one or more limiting factors. For example, the limiting factors may specify a limit on an amount of time that may be spent by the recommender system in generating the recommendation, a limit on an



Application No: 09/902,407  
Attorney's Docket No: US010319

amount of power consumption utilized in conjunction with generating the recommendation, or a limit on a quality measure associated with the recommendation. A given limiting factor may be selectable by the user as one of a plurality of points along a visual display scale from a low level of the limiting factor to a high level of the limiting factor.

Claims 1, 14, and 15 recite, "the one or more limiting factors defining one or more characteristics of content to be excluded by an output recommendation of the recommender system." Kramer et al. fails to disclose, teach or suggest the above-quoted subject matter. Rather, Kramer et al. discloses methods of targeting customers by providing customized information to the customer. The Office Action alleges that Kramer et al. discloses receiving one or more limiting factors in a recommender system at column 31 lines 47-63 and column 32 line 39 to column 33 line 20. These passages describe a system wherein a consumer is allowed to adjust a content rotator to adjust what kind of recommendations are presented to the consumer. However, these inputs are directly related to and characteristic of the output recommendation. In contrast, claims 1, 14, and 15 recite that the limiting factors define a characteristic of content to be excluded, not a characteristic of content *to be included*. In other words, Kramer et al. directly teaches away from the subject matter recited in the rejected claims. For at least the foregoing reasons, Kramer et al. fails to disclose, teach or suggest the subject matter according to the combinations recited in claims 1, 14, and 15.

Claims 1, 14, and 15 are allowable for at least the foregoing reasons. Claims 5, 8, and 10-13 depend upon allowable claim 1 and are also allowable at least by virtue of their dependencies.



Application No: 09/902,407  
Attorney's Docket No: US010319

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 2 and 9 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kramer et al. as applied to claim 1 and further in view of Sciammarella et al. Claims 2 and 9 depend from amended claim 1. The Applicants submit that amended claim 1 is not anticipated by Kramer et al. In addition, the Office Action does not rely upon Sciammarella et al. to make up for the deficiencies in Kramer et al. with respect to amended claim 1. Therefore, claims 2 and 9 which depend from amended claim 1 are allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 2 and 9.



Application No: 09/902,407  
Attorney's Docket No: US010319

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kramer et al. in view of Sciammarella et al. as applied to claim 2 and further in view of Official Notice. Claims 3 and 4 depend from claim 2. The Applicants submit that claim 2 is not obvious over Kramer et al. in view of Sciammarella et al. In addition, the Official Action does not rely upon Official Notice to make up for the deficiencies in Kramer et al. and Sciammarella et al. with respect to claim 2. Therefore, claims 2 and 4 which depend from claim 2 are allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 3 and 4.

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kramer et al. in view of Shaw. Claims 6 and 7 depend from amended claim 1. The Applicants submit that amended claim 1 is not anticipated by Kramer et al. In addition, the Office Action does not rely upon Shaw to make up for the deficiencies in Kramer et al. with respect to amended claim 1. Therefore, claims 6 and 7 which depend from amended claim 1 are allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 6 and 7.

### Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully



Application No: 09/902,407  
Attorney's Docket No: US010319

requested that the Examiner telephone the correspondence attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,  
KRAMER & AMADO, P.C.



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Mark R. Woodall  
Reg. No. 43,286

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KRAMER & AMADO, P.C.  
1725 Duke Street, Suite 240  
Alexandria, VA 22314  
Phone: 703-519-9801  
Fax: 703-519-9802

**MAIL ALL CORRESPONDENCE TO :**

Yan Glickberg, Registration No. 51,742  
US PHILIPS CORPORATION  
P.O. BOX 3001  
Briarcliff Manor, NY 10510-8001  
Phone : (914) 333-9618  
Fax : (914) 332-0615